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TOWNSEND and TOWNSEND and CREW LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Cecily Anne Snyder

Application No.: 09/996,341

Filed: November 27, 2001

For: DOCKETING SYSTEM

Confirmation No. 1973

Examiner: Susanna M. Meinecke Diaz

Technology Center/Art Unit: 3623

APPELLANT'S BRIEF UNDER
37 CFR §41.37

Via EFS-Web

Mail Stop Appeal Brief

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on October 26, 2006 for the above-referenced application, Appellant submits this Brief on Appeal.

TABLE OF CONTENTS

1. REAL PARTY IN INTEREST	3
2. RELATED APPEALS AND INTERFERENCES.....	3
3. STATUS OF CLAIMS	3
4. STATUS OF AMENDMENTS	3
5. SUMMARY OF CLAIMED SUBJECT MATTER	4
6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	7
7. ARGUMENT	7
8. CONCLUSION.....	11
9. CLAIMS APPENDIX.....	12
10. EVIDENCE APPENDIX.....	20
11. RELATED PROCEEDINGS APPENDIX.....	21

1. REAL PARTY IN INTEREST

The real party in interest in this appeal is First To File Inc. of Menlo Park, CA as the Assignee of the above-identified application.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. STATUS OF CLAIMS

Claims 1-3 and 5-26 are currently pending in this application. All pending claims stand finally rejected pursuant to a Final Office Action mailed August 10, 2006. More specifically, claims 1, 2, and 5-20 have been rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent No. 6,859,806 to Kamarei et al. (hereinafter "Kamarei"). Claim 3 has been rejected under § 103(a) as being unpatentable over Kamarei. Claims 21-26 have been rejected under § 103(a) as unpatentable over Kameranai in combination with US Patent No. 7,016,852 to Lee (hereinafter "Lee"). These rejections of claims 1-3 and 5-26 are believed to be improper and are the subject of this appeal. A copy of the claims as rejected is attached as 9. **Claims Appendix.**

4. STATUS OF AMENDMENTS

The claims have been amended once in this case. More specifically, an amendment was filed on July 18, 2006 in response to the Office Action dated January 18, 2006. In this amendment, claims 1, 11, 12, 16, and 17 were amended, claim 4 was canceled, and claims 21-26 were added.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The invention generally relates to managing calendar-based deadlines, and more particularly to recording, tracking, and reporting out deadlines for performing actions such as associated with legal cases including intellectual property cases. Application, page 2, lines 3-4 and page 4, lines 7-8. The embodiment of claim 1 relates to a computer-implemented method of generating a message for a first intellectual property case. Id. at page 4, lines 12-14, page 11, line 31 - page 12, line 3, page 23, lines 4-6, and FIG. 11. The method of this embodiment includes storing information related to a plurality of intellectual property cases on a computer-readable medium. Id. at page 4, lines 17-20, page 9, line 20, and page 12, lines 5-7. The plurality of intellectual property cases can include the first intellectual property case. Id. at page 4, lines 17-20. Storing information related to the first intellectual property case can comprise storing the information related to the first intellectual property case in a case data unit. Id. at page 13, lines 15-17. The case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case. Id. at page 13, lines 22-24. A signal indicating occurrence of an event related to the first intellectual property case can be received. Id. at page 4, lines 20-21 and page 23, lines 10-12. Responsive to receiving the signal, one or more rules associated with the event can be identified. Id. at page 4, lines 21-22 and page 23, lines 32-33. At least a first rule from the one or more rules can be identified based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium. Id. at page 4, lines 22-25 and page 24, lines 4-16. At least one message can be generated using the at least first rule. Id. at page 4, lines 25-28 and page 24, lines 21-22. The message can identify an action to be performed in response to the event and identifying a date associated with the action. Id. at page 4, lines 25-28 and page 24, lines 22-25. The at least one message can be communicated to a first designated client system. Id. at page 4, lines 25-28 and page 25, lines 5-8.

The embodiment of claim 11 relates to a system for generating a message for a first intellectual property case. Id. at page 4, lines 7-15, page 6, lines 16-21, page 7, lines 7-9, and page 8, line 32 - page 9, line 4. The system of this embodiment includes a processor (Id. at page 11, lines 3-7) and a memory coupled to the processor (Id. at page 11, lines 7-9). The memory can be configured to store information related to a plurality of intellectual property cases, the plurality of intellectual property cases including the first intellectual property case, and a computer program. Id. at page 4, lines 17-20, page 9, line 20, and page 11, line 31 - page 12, line 7. The processor is operative with the computer program to store in the memory information related to the first intellectual property case. Id. at page 12, lines 5-7 and page 13, lines 12-13. Storing information related to the first intellectual property case can comprise storing the information related to the first intellectual property case in a case data unit. Id. at page 13, lines 15-17. The case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case. Id. at page 13, lines 22-24. A signal indicating occurrence of an event related to the first intellectual property case can be received. Id. at page 4, lines 20-21 and page 23, lines 10-12. Responsive to receiving the signal, one or more rules associated with the event can be identified. Id. at page 4, lines 21-22 and page 23, lines 32-33. At least a first rule from the one or more rules can be identified based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium. Id. at page 4, lines 22-25 and page 24, lines 4-16. At least one message can be generated using the at least first rule. Id. at page 4, lines 25-28 and page 24, lines 21-22. The message can identify an action to be performed in response to the event and identifying a date associated with the action. Id. at page 4, lines 25-28 and page 24, lines 22-25. The at least one message can be communicated to a first designated client system. Id. at page 4, lines 25-28 and page 25, lines 5-8.

The embodiment of claim 16 relates to a docketing system. Id. at page 4, lines 7-8, page 6, lines 8-9, and page 7, lines 7-9. The system of this embodiment includes a storage module. Id. at page 9, lines 27-29, page 11 and lines 7-9. The storage module can be configured to store information related to a plurality of intellectual property cases on a computer-readable

medium, Id. at page 4, lines 17-20, page 9, line 20, and page 11, line 31 - page 12, line 9. The plurality of intellectual property cases can include the first intellectual property case. Id. at page 4, lines 17-20. The information related to each intellectual property case in the plurality of intellectual property cases can include data related to the intellectual property case and one or more documents related to the intellectual property case. Id. at page 13, lines 22-24. The system can also include a processing module. Id. at page 11, lines 3-7. The processing module configured to receive a signal indicating occurrence of an event related to the first intellectual property case. Id. at page 4, lines 20-21 and page 23, lines 10-12. One or more rules associated with the event can be identified. Id. at page 4, lines 21-22 and page 23, lines 32-33. At least a first rule from the one or more rules can be identified based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium. Id. at page 4, lines 22-25 and page 24, lines 4-16. At least one message can be generated using the at least first rule. Id. at page 4, lines 25-28 and page 24, lines 21-22. The message can identify an action to be performed in response to the event and identifying a date associated with the action. Id. at page 4, lines 25-28 and page 24, lines 22-25. The system can also include a communications module configured to communicate the at least one message to a first designated client system. Id. at page 4, lines 25-28, page 7, lines 16-18, page 8, lines 7-10, page 11, lines 7-9, and page 25, lines 5-8.

The embodiment of claim 17 relates to a computer program stored on a computer-readable storage medium for generating a message for a first intellectual property case. Id. at page 11, line 31 - page 12, line 3. The program of this embodiment can include code for storing information related to a plurality of intellectual property cases on a computer-readable medium. Id. at page 4, lines 17-20, page 9, line 20, and page 12, lines 5-7. The plurality of intellectual property cases can include the first intellectual property case. Id. at page 4, lines 17-20. Storing information related to the first intellectual property case can comprise storing the information related to the first intellectual property case in a case data unit. Id. at page 13, lines 15-17. The case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case. Id. at page 13, lines 22-24. A signal indicating

occurrence of an event related to the first intellectual property case can be received. *Id.* at page 4, lines 20-21 and page 23, lines 10-12. Responsive to receiving the signal, one or more rules associated with the event can be identified. *Id.* at page 4, lines 21-22 and page 23, lines 32-33. At least a first rule from the one or more rules can be identified based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium. *Id.* at page 4, lines 22-25 and page 24, lines 4-16. At least one message can be generated using the at least first rule. *Id.* at page 4, lines 25-28 and page 24, lines 21-22. The message can identify an action to be performed in response to the event and identifying a date associated with the action. *Id.* at page 4, lines 25-28 and page 24, lines 22-25. The at least one message can be communicated to a first designated client system. *Id.* at page 4, lines 25-28 and page 25, lines 5-8.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1, 2 and 5-20, under 35 U.S.C. § 102((e), are anticipated by Kamarei.
2. Whether claim 3, under 35 U.S.C. § 103(e) is unpatentable over Kamarei.
3. Whether claims 21-26, under 35 U.S.C. § 103(a), are unpatentable over Kamarei in view of Lee.

7. ARGUMENT

1. *Whether claims 1, 2 and 5-20, under 35 U.S.C. § 102((e), are anticipated by Kamarei.*

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053

(Fed. Cir. 1987). The Appellants respectfully submit that Kamarei fails to disclose each and every claimed element. For example, Kamarei fails to disclose, either expressly or inherently, “wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case.” That is, Kamarei fails to teach a case data unit that stores one or more documents related to an intellectual property case. Instead, Kamarei merely teaches the storage of docketing information, along with triggering associated reminders and deadlines.

The Office Action dated January 18, 2006 cited Fig. 6, as well as column 8, line 45 through column 9, line 2, and column 9, line 32 through column 10, line 9 as teaching the storage of documents related to an intellectual property case. None of those passages provide such a teaching, however. Fig. 6 merely illustrates a screen showing “a default Client Rules Subset 42.” Kamarei, col. 9, lines 4-5. The Client Rules Subset is described thusly: “Each default Client Rules Subset preferably has Pattern Data 44 relating to a particular legal field, such as patent prosecution, trademark prosecution or litigation, an Action Prompt 30 associated with the Pattern Data and Time Calculus 46.” *Id.*, col. 9, lines 6-10.

The Office Action apparently interpreted the Action Prompt of Kamarei as teaching the storage of documents associated with an intellectual property case. A close reading of Kamarei, however, reveals that this is not the case. As Kamarei discloses, “[t]he Action Prompt 30 and Action Prompt Due Date (Not shown) provide the vehicle for notifying users of a Client System of the type of action that needs to be taken in the governmental proceeding and the time that such action should be taken, or a reminder in advance of the time an action should be taken.” *Id.*, c. 9, ll. 32-37. Clearly, the Action Prompt is merely a reminder system and has nothing to do with the storage of documents. Moreover, nothing else in the cited passages (which merely describes the functioning of the Action Prompt) teaches or suggests storing any documents related to an intellectual property case.

For example, independent claim 1 recites in part "storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case." As noted above, Kamarei fails to disclose, either expressly or inherently, "wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case."

For at least this reason, the Appellants respectfully argue that the rejection is improper and claim 1 is allowable over Kamarei. Independent claims 11 and 17 recite similar elements to those described above and therefore are considered to be allowable as well. Claim 16 recites "a storage module configured to store . . . one or more documents related to the intellectual property case." As noted above, Kamarei fails to teach or suggest such document storage, and claim 16 therefore is believed to be allowable over Kamarei as well.

In response to this argument, the final Office Action noted that Kamerai teaches that a governmental system might attach a document to a docket request message (citing Kamerai, col. 10, lines 64-67) and that Kamerai teaches that various documents might be generated in relation to a case (citing Kamerai, col. 11, lines 40-67 and col. 13, lines 55-63). Even assuming this is an accurate characterization of Kamerai, this disclosure fails to disclose the cited element, either expressly or inherently. Specifically, the final Office Action identifies nothing in Kamerai that even remotely teaches the storage of such documents, let alone the storage of such documents in a case data unit that stores data related to the first intellectual property case and one or more documents related to that case, as recited by the independent claims.

For at least these reasons, the final rejection of claims 1, 2 and 5-20 is believed to be improper. Therefore, the Appellants respectfully request reversal of the rejection and allowance of the claims.

2. *Whether claim 3, under 35 U.S.C. § 103(e) is unpatentable over Kamarei.*

Appellants respectfully submit that the rejection is improper at least for the reason that claim 3 depends upon allowable independent claim 1 as described in detail above. Furthermore, the Appellants respectfully contend that the final Office Action fails to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). However, as described above, Kamarei does not teach or suggest each claimed limitation. For example, Kamarei does not teach or suggest a case data unit that stores one or more documents related to an intellectual property case. Instead, Kamarei merely teaches the storage of docketing information, along with triggering associated reminders and deadlines.

For at least these reasons, the final rejection of claim 3 is believed to be improper. Therefore, the Appellants respectfully request reversal of the rejection and allowance of the claim.

3. *Whether claims 21-26, under 35 U.S.C. § 103(a), are unpatentable over Kamarei in view of Lee.*

Appellants respectfully submit that the rejection is improper at least for the reason that claims 21-26 each depend upon allowable base claims as described in detail above. For at

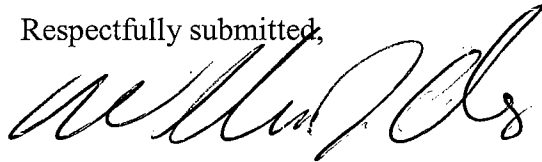
least these reasons, the final rejection of claims 21-26 is believed to be improper. Therefore, the Appellants respectfully request reversal of the rejection and allowance of the claims.

8. CONCLUSION

For these reasons, it is respectfully submitted that the rejection should be reversed.

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Respectfully submitted,



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9. CLAIMS APPENDIX

1. (Previously presented) A computer-implemented method of generating a message for a first intellectual property case, the method comprising:

storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case;

receiving a signal indicating occurrence of an event related to the first intellectual property case;

responsive to receiving the signal, identifying one or more rules associated with the event;

identifying at least a first rule from the one or more rules based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium;

generating at least one message using the at least first rule, the message identifying an action to be performed in response to the event and identifying a date associated with the action; and

communicating the at least one message to a first designated client system.

2. (Original) The method of claim 1 wherein the plurality of intellectual property cases includes patent cases and the first intellectual property case is a patent application case.

3. (Original) The method of claim 1 wherein the plurality of intellectual property cases includes trademark cases and copyright cases.

4. (Canceled)

5. (Original) The method of claim 1 wherein the signal indicating occurrence of the event related to the first intellectual property case is generated responsive to a change in the information related to the first intellectual property case.

6. (Original) The method of claim 1 wherein identifying the at least first rule from the one or more rules based upon the filter criteria information comprises:

determining a set of rules from the one or more rules associated with the event, wherein a rule from the one or more rules is included in the set of rules if the filter criteria associated with the rule is satisfied by the information related to the first intellectual property case, the set of rules including the at least first rule.

7. (Original) The method of claim 6 wherein:

the plurality of intellectual property cases includes patent cases and the first intellectual property case is a patent application case; and

the filter criteria associated with each rule in the one or more rules comprises a criterion related to filing status of a patent case, a criterion related to a type of the patent case, and a criterion related to priority information for a patent case.

8. (Original) The method of claim 1 wherein generating the at least one message using the at least first rule comprises:

determining an action associated with the at least first rule;

determining a date generation formula associated with the action and a base date used by the date generation formula;

applying the date generation formula to the base date to generate the date associated with the action; and

including information indicating the action associated with the at least first rule and the date generated by applying the date generation formula in the at least one message.

9. (Original) The method of claim 1 wherein communicating the at least one message to the first designated client system comprises:

determining one or more users associated with the first intellectual property case
from information related to the first intellectual property case;

from the one or more users, determining a first user who is designated to receive
the at least one message generated using the first rule;

communicating the at least one message to a system used by the first user.

10. (Original) The method of claim 9 wherein communicating the at least one
message to the system used by the first user comprises:

sending an electronic mail message to first user, the electronic mail message
including the at least one message.

11. (Previously presented) A system for generating a message for a first intellectual
property case, the method comprising:

a processor; and

a memory coupled to the processor, the memory configured to store:

information related to a plurality of intellectual property cases, the
plurality of intellectual property cases including the first intellectual property case; and

a computer program;

wherein the processor is operative with the computer program to:

store in the memory information related to the first intellectual property case,
wherein storing information related to the first intellectual property case comprises storing the
information related to the first intellectual property case in a case data unit, wherein the case data
unit stores data related to the first intellectual property case and one or more documents related
to the first intellectual property case;

receive a signal indicating occurrence of an event related to the first
intellectual property case;

identify one or more rules associated with the event responsive to
receiving the signal;

identify at least a first rule from the one or more rules based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored in the memory;

generate at least one message using the at least first rule, the message identifying an action to be performed in response to the event and identifying a date associated with the action; and

communicate the at least one message to a first designated client system.

12. (Previously presented) The system of claim 11 wherein:
the plurality of intellectual property cases includes patent cases and the first intellectual property case is a patent application case.

13. (Original) The system of claim 11 wherein:
the plurality of intellectual property cases includes patent cases and the first intellectual property case is a patent application case; and
the processor is operative with the computer program to determine a set of rules from the one or more rules associated with the event, wherein a rule from the one or more rules is included in the set of rules if the filter criteria associated with the rule is satisfied by the information related to the first intellectual property case, the set of rules including the at least first rule.

14. (Original) The system of claim 11 wherein the processor is operative with the computer program to:
determine an action associated with the at least first rule;
determine a date generation formula associated with the action and a base date used by the date generation formula;
apply the date generation formula to the base date to generate the date associated with the action; and
include information indicating the action associated with the at least first rule and the date generated by applying the date generation formula in the at least one message.

15. (Original) The system of claim 11 wherein the processor is operative with the computer program to:

determine one or more users associated with the first intellectual property case from information related to the first intellectual property case;

from the one or more users, determine a first user who is designated to receive the at least one message generated using the first rule;

communicating the at least one message to a system used by the first user.

16. (Previously presented) A docketing system comprising:

a storage module, the storage module configured to store information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, the information related to each intellectual property case in the plurality of intellectual property cases including data related to the intellectual property case and one or more documents related to the intellectual property case;

a processing module, the processing module configured to:

receive a signal indicating occurrence of an event related to the first intellectual property case;

identify one or more rules associated with the event;

identify at least a first rule from the one or more rules based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium; and

generate at least one message using the at least first rule, the message identifying an action to be performed in response to the event and identifying a date associated with the action; and

a communications module configured to communicate the at least one message to a first designated client system.

17. (Previously presented) A computer program stored on a computer-readable storage medium for generating a message for a first intellectual property case, the computer program product comprising:

code for storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case;

code for receiving a signal indicating occurrence of an event related to the first intellectual property case;

code for identifying one or more rules associated with the event;

code for identifying at least a first rule from the one or more rules based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium;

code for generating at least one message using the at least first rule, the message identifying an action to be performed in response to the event and identifying a date associated with the action; and

code for communicating the at least one message to a first designated client system.

18. (Original) The computer program product of claim 17 wherein the code for identifying the at least first rule from the one or more rules based upon the filter criteria information comprises:

code for determining a set of rules from the one or more rules associated with the event, wherein a rule from the one or more rules is included in the set of rules if the filter criteria associated with the rule is satisfied by the information related to the first intellectual property case, the set of rules including the at least first rule.

19. (Original) The computer program product of claim 17 wherein the code for generating the at least one message using the at least first rule comprises:

- code for determining an action associated with the at least first rule;
- code for determining a date generation formula associated with the action and a base date used by the date generation formula;
- code for applying the date generation formula to the base date to generate the date associated with the action; and
- code for including information indicating the action associated with the at least first rule and the date generated by applying the date generation formula in the at least one message.

20. (Original) The computer program product of claim 17 wherein the code for communicating the at least one message to the first designated client system comprises:

- code for determining one or more users associated with the first intellectual property case from information related to the first intellectual property case;
- code for determining a first user from the one or more users who is designated to receive the at least one message generated using the first rule; and
- code for communicating the at least one message to a system used by the first user.

21. (Previously presented) The method of claim 1, wherein the one or more documents comprise one or more documents selected from the group consisting of: an invention disclosure, a filed patent application, a patent drawing, an old version of a patent application, an office action, and a response to an office action.

22. (Previously presented) The method of claim 21, wherein storing the one or more documents comprises storing each document as part of a document entity that comprises the document and a set of meta-data about the document.

23. (Previously presented) The method of claim 22, wherein the set of meta-data about the document comprises one or more data elements selected from the group consisting of a document ID, a document type, an originator, a status, a security profile, a file format, a creation date, a last modified date, a set of physical file attributes, a set of search field key words, a completion date, and a list of witness names.

24. (Previously presented) The method of claim 1, further comprising:
scanning a paper to produce a scanned document in a computer readable format;
wherein storing one or more documents comprises storing the scanned document.

25. (Previously presented) The method of claim 24, further comprising:
subjecting the scanned document to optical character recognition to recognize
data from one or more fields from the scanned document;
wherein storing the data related to the intellectual property case comprises storing
the recognized data in the case data unit.

26. (Previously presented) The method of claim 25, wherein the signal indicating
occurrence of the event related to the first intellectual property case is generated responsive to
the recognized data.

10. EVIDENCE APPENDIX

None.

11. RELATED PROCEEDINGS APPENDIX

None.